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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/742,803      | 12/19/2000  | Gary R. McLuen       | NEI-00104           | 7285             |

28960 7590 09/22/2006

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| EXAMINER |
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HANDY, DWAYNE K

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| ART UNIT | PAPER NUMBER |
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1743

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/742,803

**Applicant(s)**

MCLUEN ET AL.

**Examiner**

Dwayne K. Handy

**Art Unit**

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-30,35-38,40,42 and 44-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-30,35-38,40,42 and 44-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-30, 35-38, 40, 42 and 44-48 are rejected under 35 U.S.C. 102(b) as being anticipated by McGraw et al. (5,368,823). This rejection was upheld in the previous Office Action (mailed 3/22/06). It remains in effect. Please see Response to Arguments below.

3. Claims 27-30, 35, 36, 38 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuckerman et al. (5,240,680). Zuckerman teaches an automatic apparatus for use in peptide synthesis. The device is best shown in Figures 2 and 3 and described in column 3. As shown in the Figures, the device includes a vessel (14) having an interior dimension to hold a frit (27) and a solid support (not shown).

4. Claims 27-30, 35, 36, 38 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Cargill et al. (5,609,826). Cargill teaches a method and apparatus for the generation of chemical libraries. The elements of the device most relevant to the instant claims are shown in Figures 2A, 3 and 4, and described in columns 7 and 8. As shown

in Figure 2A, the device includes reaction vessels (110) having an interior dimension to hold a frit (125) and a solid support (not shown).

### ***Response to Arguments***

5. Applicant's arguments filed 7/25/06 have been fully considered but they are not persuasive. Applicant has argued the following in traversing the rejection under McGraw: (1) McGraw does not teach a single frit; (2) McGraw does not teach an exterior dimension to fit directly within a receiving hole of a cartridge.
6. As previously noted by the Examiner, Applicant appears to want to exclude the presence of a second frit in the vial. The Examiner did recommend the use of "consisting" language – and Applicant has added this language - but Applicant appears to have used it to limit the frit and not the vial. This was noted by the Examiner in the Advisory Action (mailed 6/22/06). The claim as currently written recites a "frit consisting of a single frit". If Applicant wishes to overcome the rejection of McGraw using this language, then Applicant needs to amend the claim to recite a "vial consisting essentially of a single frit" and not a "frit consisting of a single frit". A "frit consisting essentially of a single frit" is simply a recitation of a frit and does not exclude another frit from being in the vial. For this reason, the rejection under McGraw remains.

The Examiner also wishes to note that this issue is moot with respect to the new references – Zuckermann and Cargill – since these references teach only a single frit in their vessels anyway.

7. Applicant has also argued that McGraw does not teach an exterior dimension to fit directly within a receiving hole of a cartridge. The Examiner has previously argued that McGraw does indeed explicitly show this feature. See Advisory Action mailed 6/22/06 and Office Action Mailed 3/22/06. Even if this weren't shown in McGraw, however, the Examiner submits that the vial of McGraw still meets this limitation (as do new references Zuckermann and Cargill). The claim as currently written does not include the hole of the cartridge or even the cartridge. Applicant has not claimed the cartridge. Therefore, Applicant is attempting to limit an element of the claimed device – an exterior dimension of the vial – by using another, unclaimed element – a cartridge hole. The Examiner submits that there is no structural limitation that is provided by this phrase. The vials/vessels of the prior art have a dimension that would allow them to fit directly into the receiving hole of a cartridge in a pressure tight seal.

### ***Conclusion***


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH  
September 15, 2006

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700